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February 22, 2006

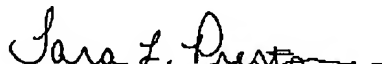
To: Examiner Ann Y. Lam Fax No.: (571) 273-8300
From: Stephen P. Burr Fax No.: (315) 233-8320
Re: U.S. Patent Application Serial No. 10/068,292
Title: BIOCHIP AND METHOD FOR PRODUCING THE SAME
Conf. No.: 9651
Our Ref.: 789_076

You should receive 6 page(s) including this cover sheet. If you do not receive all pages, please call Tara at (315) 233-8300.

COMMENTS:

I hereby certify that the following paper(s) is/are being transmitted by facsimile to the Patent and Trademark Office on February 22, 2006:

	<u>Pages</u>
- a Transmittal form	1
- a Request for Reconsideration	4
Total:	6 (including cover)


Tara L. Preston

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TRANSMITTAL (Provisions of 37 CFR 1.136 Apply)				RECEIVED CENTRAL FAX CENTER	
Application Number	10/068,292	Filing Date	February 6, 2006		
Group Art Unit	1641	Examiner Name	Ann Y. Lam		
Confirmation No.	9651	Attorney Docket No.	789_076		
Inventor(s)	Toshikazu HIROTA, Takao OHNISHI, Saichi YAMADA, Kazumari YAMADA, Yukihiisa TAKEUCHI				
Invention:	BIOCHIP AND METHOD FOR PRODUCING THE SAME				

Transmitted herewith is a Request for Reconsideration in the above-identified application. The fee has been calculated as follows:

CLAIMS

(1)	(2) Claims	(3)	(4) Highest Number Previously Paid	(5) No. of Extra Claims Present	(6) Rate (Large Entity)	(7) Additional Fee
TOTAL CLAIMS	32	MINUS	57	0	\$50.00	\$00.00
INDEP. CLAIMS	1	MINUS	3	0	\$200.00	\$00.00
TOTAL ADDITIONAL FEE						\$00.00

EXTENSION OF TERM

- ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.
- ☐ This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application. The requested extension and appropriate non-small entity fee are as follows:

- ☐ One Month (37 CFR 1.17(a)(1)) \$120.00
- ☐ Two Month (37 CFR 1.17(a)(2)) \$450.00
- ☐ Three Month (37 CFR 1.17(a)(3)) \$1,020.00

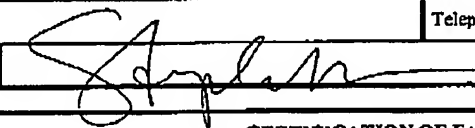
TOTAL FEES DUE

\$ 0.00

- ☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee amount is reduced by one-half, and the resulting fee is:

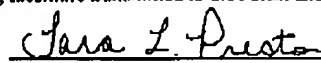
FEE PAYMENT

- ☒ No additional fee is required. ☐ A check in the amount of \$_____ is enclosed.
- ☐ Charge Deposit Account 50-1446 in the amount of \$. Enclosed is a duplicate copy of this sheet.
- ☒ Please charge any fees which may be required, or credit any overpayment, to Deposit Account 50-1446.

Submitted By:					
Name (Print Type)	Stephen P. Burr	Reg. No.	32,970	Customer No.	025191
		Telephone	(315) 233-8300	Facsimile	(315) 233-8320
Signature				Date	February 22, 2006

CERTIFICATION OF FACSIMILE TRANSMISSION

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Tara L. Preston

Practitioner's Docket No.: 789_076

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Toshikazu HIROTA, Takao OHNISHI, Saichi
YAMADA, Kazunari YAMADA and Yukihiisa
TAKEUCHI

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FEB 22 2006

Serial No.: 10/068,292

Group Art Unit: 1641

Filed: February 6, 2002

Examiner: Lam, Ann Y.

Conf. No.: 9651

For: BIOCHIP AND METHOD FOR PRODUCING THE SAME

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**CERTIFICATION OF FACSIMILE
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273-8300 in the Patent and Trademark Office on February 22, 2006.

Tara L. Preston

Tara L. Preston

REQUEST FOR RECONSIDERATION

Sir:

In response to the Office Action mailed November 28, 2005, Applicants respectfully request reconsideration and withdrawal of the rejections of record based on the following arguments.

1. Claims 7-32 and 58-63 were rejected under §112, second paragraph. This rejection is respectfully traversed.

Applicants submit that the Examiner's interpretation of "said solution" is correct. The solution being referred to as "said solution" is the solution containing no sample. Correspondingly, the solution being referred to as "said solution sample" is the solution containing the sample. In light of this discussion, reconsideration and withdrawal of this rejection are respectfully requested.

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2. Claims 7-9, 11, 14, 16-19, 21, 22, 26-32 and 59 were rejected under §102(b) over Brennan. This rejection is respectfully traversed.

Claim 7 recites a method for producing a biochip comprising the steps of supplying a plurality of solution samples, each containing a capture, and supplying a solution containing no capture. One of the solution sample and the solution is supplied onto the other one of the solution sample and the solution while the other one of the solution sample and the solution is in solution form.

As described in page 20, lines 6-14 of the present application, the solution sample and the solution are supplied separately, but each while the other is in solution form, so that neither solution is deteriorated by drying or the like brought about by being left exposed to the atmosphere. Furthermore, as shown in Figs. 4A-C and Figs. 9A-C of the present application, when the solution sample 14 and the solution 16 are applied in accordance with claim 7, the solution sample 14 and the solution 16 are freely miscible with each other, as is shown in Figs. 4C and 9C.

Brennan discloses, in column 7, lines 26-56, placement of droplets of a solution containing captures onto a hydroxyalkylsiloxane dot surface, the dot surface having a surface tension of approximately $\gamma=47$. Brennan further discloses that the hydroalkylsiloxane surface is completely wetted by the solution containing the capture and that the solution containing capture beads up on the hydroxyalkylsiloxane dot surfaces, as shown in Fig. 3.

Applicants respectfully submit that one skilled in the art would have understood from the disclosure of Brennan, that the hydroalkylsiloxane dot surfaces of Brennan are cured, and thus are not in solution form at the time a second solution is added. The Examiner stated in the pending Office Action that she interprets the hydroalkylsiloxane solution of Brennan to be "in solution form because it is disclosed as having a surface tension." Brennan itself contradicts this interpretation in column 4, lines 51-53, which state that "the wetting phenomena is a measure of the surface tension or structured forces between the molecules *at a solid-liquid interface*"

(emphasis added). Therefore, it is incorrect to conclude that a surface is in solution form merely because it has an associated surface tension value.

Additionally, the disclosure in Brennan that "the solution beads up on the hydroalkylsiloxane dot surfaces" further supports the fact that the hydroalkylsiloxane dot surfaces are not in solution form. As disclosed above, one of the benefits of the present invention is that when the two solutions are supplied separately, each while the other is in solution form, the two solutions are freely miscible with each other. Therefore, Brennan's disclosure stating that the solution "beads up" on the hydroalkylsiloxane solution clearly indicates that the hydroalkylsiloxane solution is not in solution form when the second solution is supplied.

For at least the reasons stated above, Brennan fails to disclose a method for producing a biochip wherein one of the solution sample and the solution is supplied onto the other one of the solution sample and the solution while the other one of the solution sample and the solution is in solution form, as recited in claim 7. Since claims 8, 9, 11, 14, 16-19, 21, 22, 26-32 and 59 depend either directly or indirectly from claim 7, those claims are also believed to be allowable over the applied art. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

3. The remaining rejections relating to claims 10, 12, 13, 15, 20, 23-25, 58 and 60-63 are noted, but deemed moot in view of the arguments outlined above. Applicants respectfully submit that the arguments submitted distinguish claim 7 from Brennan. Since claims 10, 12, 13, 15, 20, 23-25, 58 and 60-63 depend either directly or indirectly from claim 7, those claims are also believed to be allowable over the applied art. Accordingly, reconsideration and withdrawal of these rejections are respectfully requested.

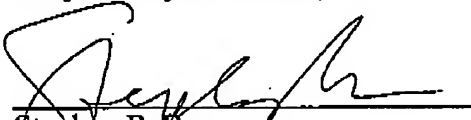
For at least the foregoing reasons, Applicants respectfully submit that all pending claims herein define patentable subject matter over the art of record. Accordingly, the Examiner is requested to issue a Notice of Allowance for this application in due course.

If the Examiner believes that contact with Applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicants' attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-1446.

Respectfully submitted,

February 22, 2006
Date


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SPB/TE/tlp

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